

REMARKS/ARGUMENTS

The Examiner is thanked for the performance of a thorough search. By this response, Claims 1-3, 5-6, 25-27, 29-30, 49-51 and 53-54 have been amended. No claims have been added or canceled. Hence, Claims 1-72 are pending in the application. All issues raised in the Office Action mailed July 2, 2004 are addressed herein. In view of the comments provided hereinafter, reconsideration is respectfully requested.

SUMMARY OF THE REJECTIONS/OBJECTIONS

The issues raised in the Office Action mailed on July 2, 2004 are summarized below. Each of these issued is discussed hereinafter.

1. Claims 1-13 and 16-19 are rejected under 35 U.S.C. § 102(e) as being anticipated by Landsman et al., U.S. Patent No. 6,317,761 (hereinafter "Landsman").
2. Claims 14-15, 38-39 and 63-64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Landsman further in view of Ackermann, Jr. et al., U.S. Patent No. 6,606, 653 (hereinafter "Ackermann").
3. Claims 20, 44 and 68 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Landsman further in view of Underwood, U.S. Patent No. 6,704, 873 (hereinafter "Underwood")
4. Claims 21-23, 45-47 and 69-71 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Landsman further in view of Markus, U.S. Patent No. 6,499, 042 (hereinafter "Markus")
5. Claims 24, 48 and 72 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Landsman further in view of Shapiro et al., U.S. Patent No. 5,991, 810 (hereinafter "Shapiro")

THE REJECTIONS BASED ON THE PRIOR ART

A. REJECTION OF CLAIMS 1-13 AND 16-19 UNDER 35 U.S.C. §102(e).

Claims 1-13 and 16-18 are rejected under 35 U.S.C. § 102(e) as being unpatentable over Landsman. It is respectfully submitted that Claims 1-13 and 16-19 are patentable for at least the reasons provided hereinafter.

CLAIM 1

To establish a § 102(e) anticipation rejection all the claim limitations must be taught by the prior art. See MPEP 2131. Landsman is missing several features of Claim 1. Specifically, as amended, Claim 1 requires:

receiving, from a browser executing on a client, an initial request for requested content;
wherein said initial request is received at said porthole engine;
wherein said **client is connected to a network through said porthole engine**;
wherein said requested content resides on an origin server located separate from
said porthole engine on said network; and
said **porthole engine responding to said initial request by sending to said client data
generated by the porthole engine wherein the data causes said requested
content and said unrequested content to appear on a display screen of said
client.**

These limitations are not disclosed or in any way rendered obvious by Landsman. The Office Action asserted that these limitations were described in Landsman (col. 1, lines 26-35). However, the text at this portion of Landsman does not teach such features recited in Claim 1. Rather, Landsman discloses advertisements transparently downloaded to a client computer and then displayed by a browser, on an interstitial bases, in response to a click-stream generated by the user to move from one web page to the next.

It is conceded that the advertisements delivered by Landsman could be considered “unrequested content” that is delivered for display on a browser. However, Claim 1 is not directed to the general idea of delivering unrequested content, but rather Claim 1 is limited to a

very specific manner in which such unrequested content can be delivered. Further, the specific manner recited in Claim 1 has little in common with the specific manner described in Landsman.

For example, the Office Action equates Landsman's proxy server (col 8, lines 1-40) with the porthole engine recited in Claim 1. This equation is not correct. Specifically, while both a proxy server and a porthole engine serve as the "middleman" between a client and the Internet, a proxy server is typically no more than a pipe through which data communications travel. There is no disclosure or even suggestion that Landsman's proxy server would be capable of

"responding to said initial request by sending to said client data generated by the porthole server wherein the data causes said requesting content and said unrequested content to appear on a display screen of said client"

This type of functionality, expressly recited in the claim, is just not what conventional proxy servers do. Specifically, the proxy server described in Landsman does **not** generate any data, much less generate data that causes unrequested content to appear on a display screen. The proxy server described in Landsman only receives and directs onward requests for content as well as the requested content itself (col 8, lines 17-24).

In view of the foregoing, it is respectfully submitted that Claim 1 includes one or more limitations that are not in any way expressly or inherently disclosed by Landsman, and therefore Claim 1 is patentable over Landsman.

THE REMAINING CLAIMS

Claim 25 a "computer readable medium" version of Claim 1. Claim 49 is a system claim with limitations similar to those described above. The remaining claims depend, directly or indirectly, on Claim 1, 25 or 49. Therefore, all of the remaining claims are allowable for the

reason given above with respect to Claim 1. In addition, each other claim includes one or more additional limitations that independently render it patentable over the art of record. For example:

CLAIM 9

Claim 9 recites “said porthole engine determines the format in which to display said requested content and said unrequested content based on one or more factors including at least one of differences in browsers, components of requested web pages, and versions of the browsers” The Office Action asserts that this feature is taught by Landsman’s disclosure of ad selection based on user specific information collected for and associated with the user operating browser (col. 21, lines 10-28). However, ad selection based on user specific information (as disclosed in Landsman) does not correspond to a **content display format** (as recited in Claim 9). Furthermore, the proxy server described in Landsman, which is considered by the Office Action to be analogous to the porthole engine recited in Claim 9, does not determine the ad selection described in Landsman. In contrast, Claim 9 recites the content display format is determined by the porthole engine. Therefore, Landsman’s disclosure of ad selection based on specific information collection cannot possibly teach a **porthole engine which “determines the format in which to display said requested content and said unrequested content based on one or more factors including at least one of differences in browser, components or requested web pages”**.

CLAIM 11

The Office Action asserts that “the porthole engine receiving a series of subsequent request from the browser in response to the browser decoding said frame data, said series of subsequent requests including a second request for said requested content;” is expressly taught by Landsman (col. 8, lines 41-67). The text at this portion of Landsman teaches a downloading

re-start when a second request for the content is received. The application of the downloading re-start is incompatible with the features recited in Claim 11 for a couple of reasons: first, Landsman's description of a downloading re-start occurs exclusive of a first request for the content and cannot possibly correlate to the second request recited in Claim 11 which is still related to the initial request. Secondly, the subsequent request recited in Claim 11 are received by the porthole engine "from the browser in **response to the browser decoding said frame data...**" in contrast, Landsman does not teach that the downloading re-start is in response to a browser decoding frame data.

B. REJECTION OF CLAIMS 14-15, 38-39 AND 63-64 UNDER 35 U.S.C. § 103(a)

Claims 14 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Landsman further in view of Ackermann. Claims 14 and 15 depend from Claim 1 and include all the limitations recited in Claim 1. As explained above, Landsman does not teach one or more limitations required by Claim 1. The Office Action does not even allege that Ackermann fills in the limitations of Claim 1 that are missing from Landsman. Therefore, a combination of Ackermann and Landsman cannot provide all features or steps recited in Claims 14 and 15. Further, Claims 14 and 15 recite additional limitations, which are not taught or suggested by Landsman in view of Ackermann, either taken alone or in combination.

For example, the Office Action expressly states that Landsman fails to teach the limitation of "changing a target attribute of a link in an embedded frame document to affect frame behavior." The Office Action relies on Ackermann to teach this limitation. Ackermann describes the updating of embedded links or hotspots to reflect the new URL's of moved target Web Pages (see abstract and Col. 5, lines 25-44). However, Ackermann does not teach or suggest the step of rewriting a link in an embedded frame document to **affect frame behavior**.

Furthermore, Ackerman does not teach the updating of links in the context of a porthole engine sending data wherein the data causes said requested and unrequested content to appear on a display screen of said client.

Claims 38-39 and 63-64 include similar limitations to Claims 14 and 15 except Claims 38 and 39 refer to a computer-readable medium and Claims 63 and 64 refer to a system. Therefore, Claims 38-39 and 63-64 are patentable over Landsman and Ackermann for at least the reasons provided herein with respect to Claims 14 and 15.

C. REJECTION OF CLAIM 20, 44 AND 68 UNDER 35 U.S.C. § 103(a)

Claims 20, 44 and 68 and were rejected under 35 U.S.C. § 103(a) as being unpatentable over Landsman further in view of Underwood. Claim 20 depend from Claim 1 and include all the limitations recited in Claim 1. As set forth herein with respect to Claim 1, Landsman does not teach one or more limitation required by Claim 1. Therefore, a combination of Underwood and Landsman cannot provide all features or steps recited in Claim 20. Claims 44 and 68 recite similar limitations to Claim 20, except Claim 44 relates to a computer-readable medium and Claim 68 relates to a system. In addition, Claims 20 44 and 68, introduce additional limitations that independently render them patentable over Landsman in view of Underwood. However, due to the fundamental differences already identified for the claim upon which Claims 20, 44 and 68 depend, a separate discussion of those limitations are not included at this time.

D. REJECTION OF CLAIMS 21-23, 45-47 AND 69-71 UNDER 35 U.S.C. § 103(a)

Claims 21-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Landsman further in view of Markus. Claims 21-23 depend from Claim 1 and include all the limitations recited in Claim 1. As set forth herein with respect to Claim 1, Landsman does not

teach one or more limitation required by Claim 1. Therefore, a combination of Markus and Landsman cannot provide all features or steps recited in Claims 21-23. Further, limitations recited in Claims 21-23 recited additional limitations not taught or suggested by Landsman in view of Markus either taken alone or in combination.

For example, Claim 21 recites that requested content includes a web page form and, the unrequested content includes information that automatically fills in one or more fields of said web page form. The Office Action expressly states that Landsman do not teach such a feature rather, Markus is relied on for teaching this feature of Claim 21. Markus does not teach that **unrequested content includes information** that automatically fills in one or more fields of said web page form. In contrast, Markus describes that a **selective proxy server** fills in all the empty form fields in the document(col. 3, lines36-44).

Additionally, Markus does not teach or suggest “the step of automatically filling in said one or more fields of said web page form upon determining that a web page being deliver through said porthole engine is associated with said web page form and is registered in the porthole engine as fillable” as recited in Claim 22.

Furthermore, The Office Action asserts that Claim 23 which recites “the information that automatically fills in one or more fields of said web page from is provided by a database coupled to the porthole engine” is suggested by Markus col. 1, lines 40-57. The text at this portion of Markus describes the use of a selective proxy server for automatically filling in an online form and personal data storage component used to fill the forms in with. However, the personal data storage component does not correspond to the database which provides the web page forms. The personal storage component is not coupled to or associated with a porthole engine additionally, the personal data storage component stored personal data of users registered with a service managing the form-filling server (col. 1, lines 54-59).

Claims 45-47 and 69-71 include similar limitations to Claims 21-23 except that Claims 45-47 refer to a computer-readable medium and Claims 69-71 refer to a system. Therefore, Claims 45-47 and 69-71 are patentable over Landsman in view of Ackermann for at least the reasons provided herein with respect to Claims 21-23.

E. REJECTION OF CLAIMS 24, 48 AND 72 UNDER 35 U.S.C. § 103(a)

Claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Landsman further in view of Shapiro. Claim 24 depends from Claim 1 and include all the limitations recited in Claim 1. As set forth herein with respect to Claim 1, Landsman does not teach one or more limitation required by Claim 1. Therefore, a combination of Shapiro and Landsman cannot provide all features or steps recited in Claim 24. Further, limitations recited in Claim 24 recited additional limitations not taught or suggested by landsman in view of Shapiro either taken alone or in combination.

The Office action argues that Shapiro teaches “the **porthole engine** restricts access to particular web pages by using content **filtering technology** based on identities of the user” (col. 1, lines 56-67). However, Shapiro does not teach a porthole engine which restricts access to particular web pages by using filtering technology based on identities of the users. Rather, Shapiro describes restricting access to information stored on a proxy cache server and prevents the proxy cache server from retrieving web site information.

Claims 28 and 72 recite similar limitation to Claim 24 except that Claim 28 refers to a computer-readable medium and Claim 72 refers to a system. Therefore, Claims 28 and 72 are patentable over Landsman and Shapiro for at least the reason provided herein with respect to Claim 24.

D. REMAINING CLAIMS

The remaining pending claims not discussed so far are dependent claims that depend on an independent claim discussed above. Because each of the dependant claims includes the limitations of the claims upon which they depend, the dependant claims are patentable for at least those reasons given above for the independent claims. Removal of the rejections with respect to the dependant claims and allowance of the dependant claims is respectfully requested. In addition, the dependent claims introduce additional limitations that independently render them patentable. However, due to the fundamental differences already identified for the independent claim, a separate discussion of those limitations are not included at this time.

III. CONCLUSIONS & MISCELLANEOUS


For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP



Brian D. Hickman
Reg. No. 35,894

1600 Willow Street
San Jose, CA 95125
(408) 414-1080
Date: 9/1/04
Facsimile: (408) 414-1076

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

on 9/1/2004 by Darci Sakamoto
Darci Sakamoto